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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 99-012												
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature _____ Typed or printed name _____		Application Number 09/316,546	Filed May 21, 1999											
		First Named Inventor Jay S. Walker												
		Art Unit 3691	Examiner Stefanos Karmis											
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <table border="0"><tr><td><input type="checkbox"/> applicant/inventor.</td><td>/Michael Downs 50252/</td></tr><tr><td><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</td><td>Signature Michael D. Downs</td></tr><tr><td><input checked="" type="checkbox"/> attorney or agent of record. Registration number 50,252</td><td>Typed or printed name (203) 461-7292</td></tr><tr><td><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</td><td>Telephone number July 9, 2007</td></tr><tr><td></td><td>Date</td></tr></table> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below".</p> <table border="1"><tr><td><input checked="" type="checkbox"/> *Total of 1 forms are submitted.</td></tr></table>				<input type="checkbox"/> applicant/inventor.	/Michael Downs 50252/	<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)	Signature Michael D. Downs	<input checked="" type="checkbox"/> attorney or agent of record. Registration number 50,252	Typed or printed name (203) 461-7292	<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	Telephone number July 9, 2007		Date	<input checked="" type="checkbox"/> *Total of 1 forms are submitted.
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This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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R E M A R K S**A. INTRODUCTION****1. Claims Status**

Claims 1-58 are pending, rejected, and are being appealed.

Claims 1-4, 6-16, 21-44, 49-54 and 56-58 stand rejected under 35 U.S.C. 102(e) as being anticipated by Herman (U.S. Patent No. 6341353). Claims 5, 17-20, 45-48 and 55 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Herman in view of U.S. Patent No. 6,161,059 issued to Tedesco et al. ("Tedesco").

2. Summary of Primary Issues for Review**2.01. Claims 1-55, 57, and 58**

The rejection of Claims 1-55, 57, and 58 relies on the Examiner's finding that specific subject matter described only in Column 46, line 61 to Column 47, line 22 of Herman is prior art to Appellants' claims.

Herman was filed after the present application, but claims priority to a provisional application (Herman PRO) that predates the actual filing date of the present application. The primary issues on appeal are thus:

(1) whether Herman PRO allows persons of ordinary skill in the art to recognize that the subject matter described in the cited portion of Herman was actually invented prior to the filing of Appellants' application, and

(2) whether the description in Herman PRO would enable a person of ordinary skill to make or use what is described in the cited portion of Herman without undue experimentation.

If the specific subject matter of Column 46, line 61 to Column 47, line 22 that is relied upon in rejecting all of the claims is not properly described in or is not properly enabled by Herman PRO, then Herman cannot support any finding of anticipation or obviousness for the asserted subject matter, and the pending rejections of Claims 1-55 must be withdrawn. The Final Office Action (mailed April 9, 2007) did not address any of Appellants' previous arguments (filed January 16, 2007) with respect to the lack of support in Herman PRO for the specific subject matter of Column 46, line 61 to Column 47, line 22 in Herman.

2.02. Claims 56-58

Herman does not teach or suggest a feature of receiving, from the merchant, a record of charge for the transaction printed by a point-of-sale terminal, as recited in Claims 56-58.

B. ARGUMENT**1. Priority Information**

This application was actually filed on May 21, 1999. The Examiner has made a finding that none of the applications to which this application claims priority (08/920116, filed August 26, 1997, and 08/822709, filed March 21, 1997) can support the subject matter of any pending

claim.¹ Reliance on the priority of any earlier application, however, is not necessary in order to overcome the pending rejections based on Herman.

Herman was filed on December 10, 1999, after the actual filing date of the present application. Herman claims the benefit of priority of Herman PRO (U.S. Provisional Patent Application No. 60/111988), filed December 12, 1998.²

2. Findings Required for Applying a § 102(e) Reference

The Examiner is relying upon the filing date of Herman PRO as establishing an effective filing date for any asserted subject matter disclosed in Herman in the cited portions.

MPEP (8th ed., Rev. 5, August 2006) provides explicit instructions for making the findings necessary to establish a reference as a § 102(e) reference (underlining added MPEP § 2136.03 (III) states:

The 35 U.S.C. 102(e) critical reference date of a U.S. patent...entitled to the benefit of the filing date of a provisional application under 35 U.S.C. 119(e) is the filing date of the provisional application...if the provisional application(s) properly supports the subject matter relied upon to make the rejection in compliance with 35 U.S.C. 112, first paragraph.

See also MPEP § 706.02(f)(1). In order for the 35 U.S.C. § 102(e) critical reference date for subject matter cited by the Examiner to be the filing date of Herman PRO, Herman PRO must comply with the written description and enablement requirements of Section 112, first paragraph with respect to that asserted subject matter. See MPEP §§ 2163.02, 2164, and 2164.01 for discussion of these requirements. In other words, it is insufficient that just any disclosure of Herman is properly supported by Herman PRO; the asserted subject matter must be properly supported.

3. Claims 1-55 and 57-58

The rejection of each of Claims 1-55, 57, and 58 is based on subject matter allegedly found in Column 47 of Herman. Appellants dispute that this asserted subject matter is properly supported by Herman PRO. Generally, the Examiner has relied upon Column 47 as allegedly teaching (1) a customer accepting an offer (and particularly a customer accepting an offer on the record of charge) and (2) providing a benefit to a customer after receiving acceptance of an offer output on a record of charge.

3.01. Claims 1-5 and 7-10: receiving an acceptance of the offer by the customer on the record of charge

Independent Claim 1 and dependent Claim 7 each recite a feature of *receiving an acceptance of the offer by the customer on the record of charge*. Claims 2-5 depend from Claim 1; Claims 8-10 depend from Claim 7.

In the Office Action mailed December 16, 2004 ("2004 Office Action"), with respect to independent Claim 1 the Examiner explicitly stated that Herman discloses "receiving an

¹ Appellants do not necessarily agree or disagree with this finding, and reserve the right to address this issue in this appeal and/or in any continuing application.

² Herman also is a continuation-in-part (CIP) of an application filed April 11, 1997, that issued as U.S. Patent No. 6,119,229 (Martinez). The Examiner explicitly "has only relied upon the provisional application, filed 12 December 1998, to establish priority and provide an effective 102(e) date." [Office Action mailed June 2, 2005, page 3].

acceptance of the offer by the customer on the record of charge (column 47, lines 15-19 and Figure 24, step 2404).” [2004 Office Action, page 4]. The rejection of Claim 7 depends explicitly on Column 47, lines 8-19 of Herman.

3.02. Claims 51-55: *receiving an indication of an acceptance of the offer by the customer on a record of charge generated at a merchant point-of-sale terminal and providing the product to the customer*

With respect to independent Claim 51, the Examiner stated that Herman discloses “providing the product to the customer (column 47, lines 8-19).” [2004 Office Action, page 9].

The Examiner appears to have misread Claim 51, and did not specifically address the claimed feature of *receiving an indication of an acceptance of the offer by the customer on a record of charge generated at a merchant point-of-sale terminal*. [2004 Office Action, page 9 (mistakenly addressing a feature of “receiving an indication of a financial account to be charged for a purchase amount corresponding to a transaction”)]. Appellants infer from the Examiner’s rejection of Claims 1 and 7 that the Examiner believes “column 47, lines 15-19 and Figure 24, step 2404” teaches acceptance of an offer by the customer on a record of charge.

3.03. Claims 6-50: *providing a benefit to the customer if the offer is accepted*

Independent Claim 6 and independent Claim 44 each recite a feature of *providing a benefit to the customer if the offer is accepted*. Claims 7-43 depend from Claim 6; Claims 44-50 depend from Claim 44. With respect to independent Claims 6 and 44 the Examiner stated that Herman discloses “providing a benefit to the customer after receiving the acceptance (column 47, lines 8-19).” [2004 Office Action, pages 5, 9].

3.04. Additional Claims

The rejections of dependent Claims 2, 3, 7, 25, 28, 29, 31, 40-43, 53, 57 and 58 also explicitly depend upon Column 47, lines 8-19 of Herman. [2004 Office Action].

3.05. “Negotiation Situation”

These specific portions of Column 47 of Herman identified above and explicitly relied upon by the Examiner in rejecting independent Claims 1, 6, 44, and 51 will be referred to collectively in this paper as “Herman Negotiation Situation.” Column 46, line 61 to Column 47, line 22 is reproduced here in its entirety:

Trusted Intermediary

The invention acts as an [sic] trusted intermediary. This is particularly useful when multiple parties that do not necessarily trust each other to interact are involved in a transaction.

A further embodiment of the invention acts as an impartial fair witness in negotiation situations. Using the Smart Receipt constructs described above, the invention provides a detailed record of the chain of events that occur during a negotiation.

Referring to FIG. 23, a Trusted Agent Server 2302 sits between a client X 2301 and a client Y 2303. The Trusted Agent Server 2302 acts as the trusted intermediary between the two parties X 2301 and Y 2303.

With respect to FIG. 24, this scenario example has user X offering to enter negotiations with user Y. The order object in the Smart Receipt chain 2401 is X’s offer to enter into negotiations 2402. Y then responds with a positive

confirmation 2403. Each LEDO has a unique owner, here, X owns the offer LEDO 2402 and Y owns the acceptance LEDO 2403.

X then begins the negotiations by issuing an offer object 2404 which is a LEDO attached to the current Smart Receipt chain. Y issues a counter-offer object 2405. X then issues another offer object 2406. Y decides that the offer is acceptable and issues an acceptance object 2407.

As noted above, the Smart Receipt provides a detailed record of each step of the negotiations. Each step is a LEDO object in the Smart Receipt chain.

Appellants note that it appears that it is the issuance of the "acceptance object 2407" after the described negotiation that the Examiner is relying on in finding Herman is prior art for the feature of acceptance of an offer on a record of charge. As discussed below, there is no support in Herman PRO for such a process.

4. The Examiner has not established by substantial evidence that Herman Negotiation Situation is adequately described or enabled by Herman PRO

In the present Office Action the Examiner does not address Column 47 or Appellants' arguments in their previous Response with respect to that asserted subject matter at all:

Herman was relied on for the teachings related to smart receipts, generated at the conclusion of a successful transaction. These smart receipts allows for multiple offer types to be transmitted to the buyer in accordance with claims. The bulk of the relied upon teachings are found at column 43, line 9 thru column 45-28. Herman PRO clearly supports the cited portions.

[Office Action mailed April 9, 2007, page 3]. Appellants do not necessarily agree or disagree that Herman PRO supports alleged teachings of Herman in Columns 43 to 45. The Examiner has never alleged that anything in Columns 43 to 45 teach the recited features specified above in Section 3, but has continued to rely explicitly on the arguments that Herman Negotiation Situation teaches the recited features and that Herman PRO properly supports Herman Negotiation Situation. The Examiner previously argued that Herman Negotiation Situation is supported by Herman PRO:

Further, the section [Column 47, lines 8-19] teaches LEDO's used for a negotiation. As mentioned above, the provisional application teaches that LEDOs are verifiable and are efficient for legal and business issues. Such negotiations are a clear example of a legal and business issues.

[Advisory Action mailed September 13, 2005]. The only argument of record for the Examiner's basis for finding support in Herman PRO thus rests entirely on an improper conclusion that Herman PRO properly supports Herman Negotiation Situation because Herman PRO would support any use of LEDOs that may be described in Herman, for any purpose that could be characterized in the abstract as a "legal or business issue." Appellants disagree.

Reliance on Herman PRO to establish priority for the cited portions is limited to what it actually describes and enables. Nothing in Herman PRO refers in any way to negotiation, would suggest that its authors considered negotiations a "clear example" of the legal and business issues generically referred to in Herman PRO, or otherwise would suggest that the authors of Herman PRO were in possession of an invention related to negotiation, much less the specific steps and features of offer and acceptance described in the cited portions of Herman. Further, nothing in Herman PRO suggests that its authors were in possession of or had invented or enabled any of the following subject matter of Herman Negotiation Situation:

embodiments for use as an impartial fair witness in negotiation situations
providing a detailed record of the chain of events that occur during a negotiation
a first user offering to enter negotiations with a second user
use of "smart receipts" for any purpose other than "as the basis for after-market consumer care" (i.e. after a consumer buys a product) (see Herman PRO, page 9 "Other Commerce Servers") or "ongoing customer support" (see Herman PRO, page 5)
creation of "smart receipts" by any entity other than a "relationship marketing server" that sends information to a "trusted agent"
a "smart receipt" comprising a "chain" of objects
a "LEDO attached to the current Smart Receipt chain"
a detailed record of each step of negotiations, in which each step is a LEDO object in a Smart Receipt chain

Accordingly, Appellants submit that the cited portions of Herman are not supported by the disclosure of Herman PRO in accordance with Section 112, first paragraph—they are neither properly described nor properly enabled. One of ordinary skill in the art could not recognize, based only on Herman PRO, that its authors were in possession of the subject matter described in the cited portions and relied upon by the Examiner. Nor could one of ordinary skill in the art, relying only on what is actually disclosed in Herman PRO, arrive at the subject matter described in the cited portions without undue experimentation.

In conclusion, Herman PRO does not provide an effective reference date for the cited subject matter that is earlier than Appellants' application, the Examiner has not established by substantial evidence that Herman is an effective § 102(e) reference for the specific features discussed above in Section 3 because Herman Negotiation Situation is not properly supported by Herman PRO, and the Section 102(e) and Section 103(a) rejections of independent Claims 1, 6, 44, and 51 (and their dependent claims 2-5, 7-43, 45-50, and 52-55) should be reconsidered and withdrawn.

5. Independent Claim 56

With respect to independent Claim 56, the Examiner states that Herman teaches "wherein redemptions can be printed on paper and taken for redemption at an actual retailer (column 38, lines 9-24)." Independent Claim 56 recites: *receiving, from the merchant, a record of charge for the transaction printed by a point-of-sale terminal*. There is no suggestion in Herman that any printed "redemption" is a Smart Receipt. Further, the Smart Receipt described in Herman is not printed by a point-of-sale terminal. It is an "XML representation of the purchase that is consistent with Transactor Networks Inc.'s Smart Receipt Document Type Description (DTD)" and is "transported and stored in LEDO in XML format." This is no hint in Herman that any Smart Receipt may be printed, much less *printed by a point-of-sale terminal*, much less would be printed *including an indication of an offer*, as explicitly recited in Claim 56.

Accordingly, Appellants submit that the Examiner has failed to establish a prima facie case of anticipation for independent Claim 56 (and dependent Claims 57 and 58). Further, Herman does not teach the receiving step of Claim 56. We respectfully request that the Examiner reconsider and withdraw the Section 102(e) rejection of Claims 56-58.